

MEG00-007



Application no. 09/945,436

2813  
#5  
Election  
8/19/03  
Mullist

July 31, 2003

TO: Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: Art Unit 2813 - Examiner Thanhha Pham

FROM: George O. Saile, Reg. No. 19,572  
28 Davis Avenue  
Poughkeepsie, N.Y. 12603

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SUBJECT: Serial #: 09/945,436  
File Date: 9/4/01  
Inventor: Jiy-Yuan Lee  
Examiner: Thanhha Pham  
Art Unit: 2813  
Title: A Method for Making High Performance RF Integrated Circuits

### RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Restriction Requirement in the Office Action dated July 15, 2003. In that office action, restriction was required to one of the following Inventions under

### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450, Alexandria, VA 22313-1450 on August 1, 2003.

Signature   
Stephen B. Ackerman, Reg. No. 37,761

Date: 8/1/03

35 U.S.C. 121:

The inventions stated are:

I - Claims 1-4 and 9-12, drawn to a method for fabricating a planar inductor high performance high-frequency semiconductor circuits, classified in class 438, subclass 381+, and

II - Claims 5-8 and 13-16, drawn to a planar inductor in high-performance high-frequency semiconductor circuits, classified in class 257, subclass 499+.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group I - Claims 1-4 and 9-12 drawn to a process classified in Class 438, subclass 381+. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner gives the reasons for the distinctness between Inventions I and II as (1) that the process as claimed can be used to make other and materially different product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the

product Claims one can readily see that the process Claims are directed to a method "for fabricating a planar inductor", and that the product claims are directed to "a planar inductor", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class/subclass 438/381+ and product class/subclass 257/499+, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "the product invention II can be made by another and materially different process, for example, etching completely penetrating through the substrate instead of using the two steps of cutting and removing the substrate material" is speculative and has nothing to do with the Claims as presented in this patent application.

Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of multiple patent applications upon the applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Still further, applicant was required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable, and that currently no claim is generic.

The method species stated are:

Species 1a., the method of fabricating a planar inductor high performance high-frequency semiconductor circuit of the 1<sup>st</sup> embodiment, as illustrated in Figs. 1-5, which reads on Claims 1-4, and

Species 1b., the method of fabricating a planar inductor high performance high-frequency semiconductor circuit of the 2nd embodiment, as illustrated in Figs. 6-8, which reads on Claims 9-12.

Applicant provisionally elects to be examined the species described by the Examiner as Species 1a., which reads on Claims 1-4. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Election of Species given in the Office Action, because of the increased costs applicant would be forced to bear if the additional species are separately examined. Furthermore, the field of search must necessarily cover both species, in addition to other related Classes and subclasses, to provide a complete and adequate search.

Withdrawal of the Election of Species Requirement, and allowance of the present Patent Application, is therefore respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'S. Ackerman', with a stylized, looped design.

Stephen B. Ackerman, Reg. No, 37,761